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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,039	09/21/2000	William J. Beyda	00P7906US	9089

7590 04/17/2007  
Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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REFAI, RAMSEY

ART UNIT	PAPER NUMBER
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2152

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

### Application No.

09/668,039

### Applicant(s)

BEYDA, WILLIAM J.

### Examiner

Ramsey Refai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 14-18 and 29-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 14-18, and 29-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Response to Amendment*

Responsive to Amendment received January 31, 2007. Claim 38 is new. Claims 1-5, 14-18, and 29-38 are pending further examination.

### *Response to Arguments*

1. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks the Applicant argues with substance:

Argument A: *Fields does not teach or suggest an "access restriction filter is configured to detect an access restriction notice in the respective ones of the electronic messages", Sato does not teach anything about detecting access restrictions notices in electronic messages of the type recited in claim 1.*

In response, the Examiner respectfully disagrees. Fields teaches a method to protect images via a server-based policy (column 2, lines 37-38). When a client requests an image or a web page containing the image, the method parses the request and examines the image. A rule for the image is evaluated against client specific data. If the condition is satisfied an image restriction is imposed. (column 2, line 36-column 3, line 15, column 7, lines 40-67). Therefore, Fields meets the scope of the claimed access restriction filter, which is configured to detect an access restriction notice in the respective ones of the electronic messages. Rejection is maintained.

Argument B: *No motivation to combine the teachings of Fields and Sato. Examiner has "engaged in hindsight reconstruction of the claimed invention".*

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some

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teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Fields et al teach a method to protect images via a server based policy (abstract) to protect a copyright owner's exclusive reproduction rights (column 1, lines 35-52). Sato teaches a method of protecting copyrighted images by detecting digital watermarks or DO NOT COPY symbols (figs 7, 14). Fields et al fail to teach the access restriction filter comprising a character recognizer configured to translate characters in image components of respective ones of electronic messages into computer-readable character representations and comparing the one or more translated computer readable character representations respectively produced by the character recognizer to respective representations of one or more access restriction notices stored-in memory. However, Sato teach a detection process for detecting copyright restriction characters on images and executes pattern matching with characters stored in memory to impose stored restriction policies, such as prevent copying of the image (column 8, lines 9-34). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Fields et al and Sato because doing so would create a way to detect copyright symbols on protected images and determine what restriction needs to be imposed on distribution of the protected image.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Argument C: *Fields does not teach an "access restriction notice indicating ownership of at least a portion of the respective ones of the electronic messages"*.

In response, the Examiner respectfully disagrees. The detecting of images that contain watermark or company logos indicate ownership of an image (column 2, lines 51-53, column 5, lines 40-67).

*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 14-18, and 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields et al (U.S. Patent No. 6,704,797) in view of Sato (U.S. Patent No. 6,914,691).

4. As per claim 1, Fields et al teach an electronic messaging system for filtering electronic messages, comprising

a message server operable to receive and transmit electronic messages including electronic mail messages (column 3, line 65), the message server comprising an access restriction filter (column 2, lines 40-58, column 6, lines 52-54);

wherein the access restriction filter is configured to detect an access restriction notice in the respective ones of the electronic messages, and, the access restriction filter being additionally configured to respond to the detection of the access restriction notice in

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accordance with a prescribed transmission policy for handling electronic messages containing the detected access restriction notice (column 2, line 35—column 3, line 15).

Fields et al fail to teach the access restriction filter comprising a character recognizer configured to translate characters in image components of respective ones of electronic messages into computer-readable character representations and comparing the one or more translated computer readable character representations respectively produced by the character recognizer to respective representations of one or more access restriction notices stored-in memory. However, Sato teach a detection process for detecting copyright restriction characters on images and executes pattern matching with characters stored in memory to impose stored restriction policies, such as prevent copying of the image (column 8, lines 9-34). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Fields et al and Sato because doing so would create a way to detect copyright symbols on protected images and determine what restriction needs to be imposed on distribution of the protected image.

5. As per claim 2, Fields et al teach wherein the access restriction filter is configured to detect in respective ones of the electronic messages an access restriction notice indicating ownership of at least a portion of the respective ones of the electronic message (column 2, lines 35-60).

6. As per claim 3, Fields et al teach wherein the access restriction filter is configured to detect a copyright notice in respective ones of the electronic message (column 1, lines 35-41, column 6, lines 50-54).

7. As per claim 4, Fields et al teach wherein the access restriction filter is configured to detect the copyright notice by comparing one or more characters in the respective ones of electronic messages to respective characters of one or more copyright notices stored in memory (column 2, line 35—column 3, line 15).

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8. As per claim 5, Fields et al teach wherein the access restriction filter is configured to detect the copyright notice by comparing characters in header component of the respective ones of electronic messages with respective characters of the one or more stored copyright notices (column 4, lines 44-67).

9. As per claim 30, Fields et al fail to explicitly teach wherein the access restriction filter is configured to detect at least one of the following access restriction notices in the electronic messages: a "confidential" notice, an "internal use only" notice, an "attorney-client privileged" notice, and an "attorney work product" notice. However, Sato teaches a method to detect character strings, which indicate, " Production copy unauthorized" or " This image is production so cannot be copied" . The detecting process extracts the character string data and recognizes the concerned data string using a character recognizing means (column 8, lines 23-35). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Fields et al and Sato because doing so would create a way to detect copyright symbols on protected images and determine what restriction needs to be imposed on distribution of the protected image.

10. As per claim 33, Fields et al teach wherein at least one of the electronic message comprises a primary message and at least one attachment, and the access restriction filter is configured to compare characters in the primary message and characters in the at least one attachment to respective characters of the one or more stored access restriction notices (column 4, lines 34-39).

11. As per claim 34 and 36, Fields et al fails to teach wherein the access restriction filter is configured to trigger display of a report to a user in response to the detection of the access restriction notice. However, Sato teaches that the user or host computer is given a warning display to notify the user that the image specified is protected (column 9, lines 12-22, column 10,

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lines 1-10). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Fields et al and Sato because doing so would create a way to detect copyright symbols on protected images and determine what restriction needs to be imposed on distribution of the protected image and notify the user of that restriction.

12. As per claim 35 and 37, Fields et al fail to teach wherein the access restriction filter is configured to trigger display of a report to a user a message reporting that a corresponding one of the electronic messages cannot be transmitted because of the detection of the access restriction. However, Sato teaches that the user or host computer is given a warning display to notify the user that the image specified is protected (column 9, lines 12-22, column 10, lines 1-10). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Fields et al and Sato because doing so would create a way to detect copyright symbols on protected images and determine what restriction needs to be imposed on distribution of the protected image and notify the user of that restriction.

13. As per claim 38, Fields-Sato teach wherein character recognizer configured to translate characters in image components of respective ones of electronic mail messages into computer-readable character representations, and the access restriction filter is configured to detect an access restriction notice in the respective ones of the electronic mail messages by comparing the one or more translated computer-readable character representations respectively produced by the character recognizer to respective representations of one or more access restriction notices stored in memory (Fields: column 2, line 35—column 3, line 15; the requested image is parsed and compared to stored policy, Sato: column 8, lines 9-34; detecting copyright restriction characters on images and executes pattern matching with characters stored in memory to impose stored restriction policies ).



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14. As per claims 14-18, 29, 31, and 32, these claims contain similar limitations as claims 1-5 and 30 above, therefore are rejected under the same rationale.

*Conclusion*

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

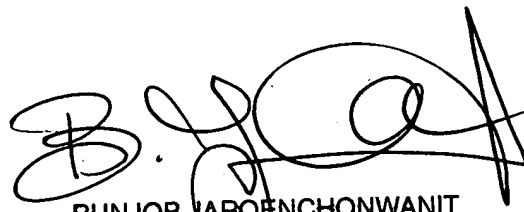
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ramsey Refai  
Examiner  
Art Unit 2152  
April 9, 2007



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SUPERVISORY PATENT EXAMINER